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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 812,181	03 19 2001	Dadong Wan	5222.00126	8231

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BANNER & WITCOFF AND ATTORNEYS FOR ACCENTURE
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CHICAGO, IL 60606

EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 04 23 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,181

Applicant(s)

WAN ET AL.

Examiner

Ahshik Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/27/03 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-11 and 14 is/are allowed.
- 6) ☒ Claim(s) 1-6, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1 ☐ Certified copies of the priority documents have been received.
- 2 ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2876

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on February 27, 2003. In the
5 amendment, claims 1 and 12 were amended. Currently, claims 1-14 remain for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

- 10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
manner in which the invention was made.

- 15 This application currently names joint inventors. In considering patentability of the
claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various
claims was commonly owned at the time any inventions covered therein were made absent any
evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out
20 the inventor and invention dates of each claim that was not commonly owned at the time a later
invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)
and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-6, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over
25 Suzuki (US 6,313,745) in view of Gustafson (US 5,756,986).

Re claims 1 and 12, Suzuki teaches a method of obtaining information about a product,
comprising that a customer observes the product being tried for its intended purpose, a product

Art Unit: 2876

tag 10 can be read during the use and transmitting the product information (col. 2, lines 25+; col. 3, lines 48+). Although Suzuki does not suggest that the tag will be removed from the retailer when the purchase is made, Suzuki does not explicitly suggest that the tag would be retained throughout the life of the product.

5 Gustafson teaches a product identification tag that is embedded/marked on the product permanently (col. 1, lines 44+). Since the marking is done permanently, the marking would last throughout the life of the garment.

 In view of Gustafson's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known permanent marking to the teachings of
10 Suzuki in order to continuously track the usage of the product or preference of the customer and therefore enhance marketing efforts and increase sales. Attaching marking/labels can be achieved permanently or detachably as Gustafson indicates. Accordingly, selecting a label/marking that can be applied permanently or temporarily is entirely dependent upon the application a user is implementing. Obviously, one ordinary skill in the art would select a
15 labeling method suitable for his/her application.

 Re claims 2, 5, and 13, the product tag 10 is a radio frequency tag, which transmit signal via RF circuitry (col. 4, lines 23+).

 Re claim 3, the system also allows the customer to purchase/order the product, which is kept in the system (col. 8, lines 36+).

20 Re claims 4 and 6, the in-store terminal includes mobile terminal or POS devices suited for wireless communication (col. 3, lines 58-62).

Art Unit: 2876

Allowable Subject Matter

3. Claims 7-11 and 14 are allowed.

4. The following is a statement of reasons for the indication of allowable subject matter: the claims are directed at a system and the method for receiving product information from RFID tag

5 applied on a product. The claims also disclose a particular referral method wherein the first customer use the product for an intended purpose of the product, and the second customer

request product information, and the first customer is rewarded in return. Previously cited

reference to Tracy (US 6,199,753) suggests RFID tags, which are widely used in retail

environment. Reference to Bezos et al. (US 6,029,141) teaches of referral reward/bonus in

10 Internet embodiment. However, the cited references, taken alone or in combination, fail to show

or fairly teach the specific method of referral wherein the referral occurs when the product is

actually used for its intended purposes as set forth in the claims mentioned above.

Response to Arguments

15 5. In the amendment, the Applicant traversed rejection as anticipated by Suzuki by

amending claims 1 and 12, and in doing so further clarified the invention disclosed in instant

application (See remarks starting on page 5). In previous Office Action, although Examiner

provided additional detail on radio frequency tag used for an EAS (electronic surveillance

system) as an example, the tag disclosed in Suzuki does not provide such embodiment.

20 Accordingly, Suzuki's tag doesn't have to be removed when a customer purchases the product.

Art Unit: 2876

Nevertheless, as indicated by the Gustafson patent (see paragraph 3), permanent or temporary labeling/marketing is well known in the art and selectively used to suit particular needs of the application.

Applicant's arguments with respect to the amended claims further clarifying the claims
5 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

10 Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
15 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2876

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Moore (US 6,456,729) discloses a label permanently applied to an item.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Patent Examiner
Art Unit 2876
April 7, 2003



THIEN M. LE
PRIMARY EXAMINER